

## PATENT

Docket No. 58086-244-181  
(Former Docket No. 16032.902140)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MURAYAMA, Yuicgu, et al.

Serial No: 09/890,799

National Phase of PCT/US1999/02445

Filed: 3 August 2001

For: Thermo-Reversible Polymer for  
Intraluminal Implant

Art Unit: 1615

Examiner: AZPURU, Carlos A.

**REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE AND FILING RECEIPT**

Commissioner for Patents  
PCT Legal (Facsimile 571 273-0459)  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The above referenced case has a rather complex history. The original PCT International filing date was 5 February 1999, and the U.S. National Phase was filed under §371 on 3 August 2001. A Notice of Missing Requirements was mailed on 4 September 2001. A response containing the Missing Requirements was mailed on 4 December 2001 but the PCT/PTO stamp on the return postcard showed a date of 30 January 2002.

Thereafter no additional papers were received in the case so a Status Check was submitted on 14 April 2004. The undersigned attorney subsequently learned that the application became abandoned on 8 May 2004 because no response was made to an Office Action mailed on 8 December 2003. No reply was made because a processing error within the PTO attached an incorrect inventor name and attorney name to the case. Unfortunately, the firm that incorrectly received the Office Action did not have the courtesy to forward the Office Action to the undersigned. The application was subsequently revived, and in the Petition Grant (see attached) the Petition Attorney noted the data error and indicated it would be corrected.

REQUEST FOR CORRECTED NOTICE.  
Submission dated 7-June-2007  
Page 2 of 3

Patent Application  
09/890,799

Unfortunately, the error was not corrected. Instead the Office misplaced the case for two years. The case has been recovered and is now ready for a Notice of Allowance, but the inventor's name and the filing date still require correction. Additional investigation by the undersigned revealed that a Notice of Acceptance (copy attached) was mailed on 12 April 2002 apparently in response to our submission of 4 December 2001. However, the Notice of Acceptance, while listing the serial number of the present case, listed an incorrect inventor name (Wolfgang Werr) and an incorrect law firm (Baker & Botts). Presumably, Baker & Botts was handling a case for Wolfgang Werr but NOT this case. In addition, the Notice of Acceptance lists the Date of Receipt of 371(c) 1, 2 and 4 as 02 January 2002 and Date of Receipt of all requirements as 02 January 2002. Clearly, these dates are incorrect as the initial National Phase filing date for the instant application is 3 August 2001 and the Date of Receipt of all requirements should be the date that the missing parts were submitted (4 December 2001) or (perhaps) the date the package was actually received by the PTO. It is not reasonable to assume that the package was not received by the PTO until 30 January 2002.

In any case the undersigned attorney respectfully requests the PTO to correct the data and issue a corrected Notice of Acceptance and/or Filing Receipt so that the present case can proceed to issue. If for any reason the PCT Legal Division requires additional information, please call the undersigned attorney at the Los Angeles telephone number (310) 229-9928. You are hereby authorized to charge any fees due and refund any surplus fees to our Deposit Account No. 22-0261. Please reference matter number 58056-244181.

Respectfully submitted,

VENABLE LLP

Date: 7-June-2007

By: Stefan J. Kirchanski

Stefan J. Kirchanski  
Registration No. 36,568  
Attorney for Applicant(s)

2049 Century Park East., 21st Floor  
Los Angeles, CA 90067  
Telephone: (310) 229-9900

REQUEST FOR CORRECTED NOTICE.  
Submission dated 7-June-2007  
Page 3 of 3

Patent Application  
09/890,799

Facsimile: (310) 229-9901  
Email: [SJKirchanski@venable.com](mailto:SJKirchanski@venable.com)

Attachments:

- 1) Copy of Petition to Revive
- 2) Copy of Incorrect Notice of Acceptance
- 3) Copy of Postcard from Submission of Missing Requirements.



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

LINER YANKELEVITZ SUNSHINE AND REGENSTREIF  
1100 GLENDON AVENUE, 14TH FLOOR  
LOS ANGELES CA 90024

**COPY MAILED**

NOV 17 2004

**OFFICE OF PETITIONS**

ON PETITION

In re Application of  
Yuichi Murayama et al.  
Application No. 09/890,799  
Deposited: August 3, 2001  
Attorney Docket No. 13054.02140

This is a decision on the petition filed August 19, 2004, under 37 CFR 1.137(a)<sup>1</sup>, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned March 9, 2004 for failure to timely respond to the non-Final Office Action mailed December 8, 2003. No requests for extensions were filed. This decision precedes the mailing of a Notice of Abandonment was mailed February 5, 2004.

Petitioner argues that the Notice mailed December 8, 2003 was not received until July 27, 2004 and points out that the address used for mailing the office action was incorrect.

A review of the file reveals that the petitioner is correct and it is noted that an error on the part of the USPTO caused the office action mailed to not be received by the applicant's representative. Thus, petitioner's delay in responding to the non-Final Office Action was unavoidable under the standard set out at 37 CFR 1.137(a).

It appears that the file with the instant application has been confused with the file of another application and that the correspondence address, the name of the inventor and other identifying information for this instant file have been transposed however, the files

<sup>1</sup> A grantable petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 CFR 1.17(l);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(e)).

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will be corrected and the agency apologizes for any inconvenience caused by its errors.

A message will be sent to Technology Center 1615 for both the correct file and that of the incorrect file to have the files reviewed for clarification of the record and for treatment of the amendment filed August 19, 2004 with the petition to revive. However, it should be noted that in order to correct the filing date, a petition under 37 CFR 1.53 will need to be filed with proof that all filing requirements were included with the file on August 3, 2001.

Telephone inquiries concerning this matter may be directed to the undersigned  
Petitions Attorney at (571) 272-3212.

*Patricia Faison-Ball*

Patricia Faison-Ball  
Senior Petitions Attorney  
Office of Petitions



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
 United States Patent and Trademark Office  
 Washington, D.C. 20231  
 (202) 707-3000

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/890,799	Wolfgang Werr	13054.02140
INTERNATIONAL APPLICATION NO.		
PCT/US99/02445		
I.A. FILING DATE		PRIORITY DATE
02/05/1999		
CONFIRMATION NO. 7938		
371 ACCEPTANCE LETTER		
 *OC00000007844259*		

Date Mailed: 04/12/2002

**NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494  
OR 1.495**

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as an Elected Office (37 CFR 1.495), has determined that the above identified International application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

01/02/2002

DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and  
(c)(4) REQUIREMENTS

01/02/2002

DATE OF RECEIPT OF ALL 35 U.S.C.  
REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- U.S. Basic National Fee
- Indication of Small Entity Status
- Copy of IPE Report
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Request for Immediate Examination
- Small Entity Statement

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Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

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LAMONT M HUNTER  
Telephone: (703) 305-3686

**PART 3 - OFFICE COPY**

FORM PCT/DO/EO/903 (371 Acceptance Notice)

# FILE

S.N. 09/890,799 File No. 13054.02140 Mailed 12/4/2001 By: SJK/kh

Title: THERMO-REVERSIBLE POLYMER FOR INTRALUMINAL IMPLANT

Client Name: Regents of the University of California

The following, due 12/4/2001 in the U.S. Patent & Trademark Office, was received in the Patent & Trademark Office on the date stamped hereon:

Patent Appln:  Prov'l  Utility  Div.  Cont.  CIP  Design

Parent/Prior Appln. No. if applicable: \_\_\_\_\_

\_\_\_\_ Pages Spec. \_\_\_\_ Page Abstract \_\_\_\_ Claims(s)

Declaration  Power of Attorney  (Copy, from parent) (2)

Assignment and Recordation Cover Sheet  (Copy) (2)

Check No. \_\_\_\_\_ for \$\_\_\_\_\_

Check No. \_\_\_\_\_ for \$\_\_\_\_\_

Assertion of Small Business Entity Status Under 37 CFR 1.27

RCE/ CPA  **FEE TO BE PAID BY DEPOSIT ACCOUNT**

Certificate of Express Mail, Label No. \_\_\_\_\_

Amendment/Response  Restriction Req.  After Final  After Allowance

Request for Extension of Time, 1 month(s)

**EXTENSION FEE TO BE PAID BY DEPOSIT ACCOUNT**

Revocation and Power of Attorney  Statement Under 37 CFR 3.73(b)

Change of Correspondence Address  Associate Power of Attorney  Associate With Customer Number

Petition for

**Copy of Notification of Missing Requirements Under 35 USC 371**

Preliminary Amendment

Letter of Transmittal

Drawings, \_\_\_\_ Sheets

Formal  Informal

Priority Document

Country Doc. No.

IDS: \_\_\_\_\_ Reference(s)

Enclosed  Listed only

Certified Copy, \_\_\_\_ Docs

Response to Missing Parts

Notice of Appeal  Brief

Issue Fee Transmittal

Advance soft copy order

S.N. 09/890,799 File No. 13054.02140 Mailed 12/4/2001 By: SJK/kh

Title: THERMO-REVERSIBLE POLYMER FOR INTRALUMINAL IMPLANT

Client Name: Regents of the University of California

The following, due 12/4/2001 in the U.S. Patent & Trademark Office, was received in the Patent & Trademark Office on the date stamped hereon:

**JC10 Rec'd PCT/PTO 30 JAN 2002**

Patent Appln:  Prov'l  Utility  Div.  Cont.  CIP  Design

Parent/Prior Appln. No. if applicable: \_\_\_\_\_

\_\_\_\_ Pages Spec. \_\_\_\_ Page Abstract \_\_\_\_ Claims(s)

Declaration  Power of Attorney  (Copy, from parent) (2)

Assignment and Recordation Cover Sheet  (Copy) (2)

Check No. \_\_\_\_\_ for \$\_\_\_\_\_

Check No. \_\_\_\_\_ for \$\_\_\_\_\_

Assertion of Small Business Entity Status Under 37 CFR 1.27

RCE/ CPA  **FEE TO BE PAID BY DEPOSIT ACCOUNT**

Certificate of Express Mail, Label No. \_\_\_\_\_

Amendment/Response  Restriction Req.  After Final  After Allowance

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**EXTENSION FEE TO BE PAID BY DEPOSIT ACCOUNT**

Revocation and Power of Attorney  Statement Under 37 CFR 3.73(b)

Change of Correspondence Address  Associate Power of Attorney  Associate With Customer Number

Petition for

**Copy of Notification of Missing Requirements Under 35 USC 371**

Preliminary Amendment

Letter of Transmittal

Drawings, \_\_\_\_ Sheets

Formal  Informal

Priority Document

Country Doc. No.

IDS: \_\_\_\_\_ Reference(s)

Enclosed  Listed only

Certified Copy, \_\_\_\_ Docs

Response to Missing Parts

Notice of Appeal  Brief

Issue Fee Transmittal

Advance soft copy order

Dear PCT Legal Division,

Please consider the following Request for Corrected Notice of Acceptance. This paper also being submitted through the EFS system in which the attachments will doubtless be clearer.  
Respectfully submitted,  
/Stefan J. Kirchanski/  
Stefan J. Kirchanski, Reg. No. 36,568

**RECEIVED**

6 JUN 2007

*Legal Staff  
International Division*